

REMARKS/ARGUMENTS

Claims 1-29 are pending in the application. In the Office Action mailed October 7, 2003, claims 1-29 were rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references.

DRAWINGS

The Examiner objected to the drawings as being informal. However, Applicant does not believe that the drawings are informal and request further clarification by the Examiner.

SPECIFICATION

The Examiner states that the application does not contain an abstract. Applicants have reviewed the application and an abstract was submitted with the application. Enclosed herein is a post card that indicates that the abstract was received by the Patent and Trademark Office on December 21, 1999. However, in order to further prosecution, Applicants included herein the abstract previously submitted with the application.

The Examiner noted the use of the Altera TM in the application. Applicants have amended the specification to capitalize Altera. Removal of the objections to the specification is respectfully requested.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

Claims 1-7, 11-17 and 21-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Sasaki et al.* (U.S. Patent No. 6,134,488), hereinafter “*Sasaki*.” For claims 1, 11, 24 and 27, the Examiner states that it would have been obvious for a person skilled in the art to include two security signatures to ensure that the external storage device was what it claimed to be and to prevent corruption of the diagnostic tool. Additionally, the use of an external storage device with matching signature authentication can be seen in U.S. Patent No. 6,525,672 to *Chainer et al.*, hereinafter “*Chainer*.”

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. *MPEP* §2142. To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142. In light of the argument regarding the *Sasaki* and *Chainer* references, there is no suggestion or motivation to modify or combine the references and the references alone or in combination do not teach or suggest all the claim limitations of the present application.

Applicants submit that there is no motivation to combine the references. The reasons stated by the Examiner (to ensure external device was what claimed to be or prevent corrupting the diagnostic tool) can be found in the instant application. See pg. 4, lines 16-17. The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. *MPEP* 2141. The tendency to resort to “hindsight” based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis

of the facts gleaned from the prior art. *MPEP 2142*. Additionally, as explained below, *Sasaki* is directed to a diagnostic tool that forces an activation signal to a target portion being diagnosed, while *Chainer* teaches using a smart card that includes an encrypted signature that can be broadcasted thereby leaving behind an electronic version of a “fingerprint” in an event of an accident or a traffic violation. There is no motivation to combine the references in order to achieve the elements of claims 1, 11, 24 and 27.

Applicants respectfully submit that the *Sasaki* and *Chainer* alone or in combination does not teach or suggest all the claim limitations of claim 1. *Sasaki* is directed to a diagnostic tool that forces an activation signal to a target portion being diagnosed. The diagnostic tool detects the current state of the target portion and compares the current state with a state predicted when the activation signal is sent to the target portion. A signal to stop a self diagnosis test for the target portion, which can vary due to the activation signal, is also sent to the vehicle. The diagnostic tool includes an external storage device interface, and a connection with an external storage device that stores a software.

Chainer teaches using a smart card that includes an encrypted signature that can be broadcasted thereby leaving behind an electronic version of a “fingerprint” in an event of an accident or a traffic violation. However, the encrypted signature is not compared or authenticated with a previously stored encrypted signature.

Thus, *Sasaki* and *Chainer* alone or in combination does not teach or suggest providing a method that includes a first external device having a first security signature and providing a second security signature within the diagnostic tool that allows the software to be downloaded when the first and second signatures are the same, as recited in claim 1. *Sasaki* and *Chainer* alone or in combination does not teach or suggest a diagnostic tool having a first storage device

including a first security signature, wherein the software is downloaded into a third storage device located within the diagnostic tool when a second security signature stored within the tool is the same as the first security signature, as recited in claim 11. Further, *Sasaki* and *Chainer* alone or in combination does not teach or suggest providing a method to prevent unauthorized downloading of software that includes providing an external device having a first security signature and a software, and downloading the software into a memory of the diagnostic tool when a second security signature included in the diagnostic tool is the same as the first security signature, as recited in claim 24. Additionally, *Sasaki* and *Chainer* alone or in combination does not teach or suggest a diagnostic tool having an external storage device including a first security signature and software, wherein the diagnostic tool downloads the software into a memory when a second security signature included within the diagnostic tool is the same as the first security signature, as recited in claim 27. Therefore, Applicants respectfully request that the Examiner withdraw the rejections and allow claims 1, 11, 24 and 27.

Claims 8-10 and 18-20 are rejected under 35 U.S.C. 103((a) as being unpatentable over *Sasaki* in view of U.S. Patent No. 6, 148, 400 to *Arnold*, hereinafter "*Arnold*." However, since claims 1 and 11, which claims 8-10 and 18-20 depend from, are believed to be patentable, said claims are also believed to be patentable. Withdrawal of the rejection is respectfully requested.

Claims 2-10, 12-23, 25-26 and 28-29 depend from claims 1, 11, 24 and 27, respectively. Because claims 1, 11, 24 and 27 are now believed to be patentable, claims 2-10, 12-23, 25-26 and 28-29, which depend therefrom are also believed to be patentable. Withdrawal of the rejections for all claims is also respectfully requested.

CLAIM REJECTIONS - DOUBLE PATENTING

The undersigned, on behalf of the petitioner, SPX CORPORATION, represents that the petitioner, SPX CORPORATION is the owner of the entire right, title and interest of U.S.

Application No. 09/468,231, filed on December 21, 1999 for OPEN ARCHITECTURE DIAGNOSTIC TOOL by virtue of an Assignment from all of the inventors thereof executed on December 20, 1999, at Reel 010519, Frame 0791, now issued as U.S. Patent 6,236,917 as well as the entire right, title and interest in the above-captioned U.S. Application No. 09/468,230 by virtue of an Assignment from all of the inventors thereof executed on December 20, 1999, filed with the U.S. Patent and Trademark Office on December 21, 1999, at Reel 11780, Frame 0429.

Petitioner hereby certifies that the above-mentioned Assignments have been reviewed and to the best of petitioner's knowledge and belief, title is in petitioner who is seeking to take this action.

Petitioner hereby disclaims the terminal part of any patent granted on the above-captioned U.S. Application No. 09/468,230 which would extend beyond the expiration of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent 6,236,917, and hereby agrees that any patent so granted on the above-captioned U.S. Application No. 09/468,230 shall be enforceable only for and during such period that the legal title to U.S. Patent 6,236,917 shall be the same as the legal title to said patent issuing from the above-captioned U.S. Application No. 09/468,230, this agreement to run with any patent granted on the above-captioned U.S. Application No. 09/468,230 and to be binding upon the grantee, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-captioned U.S. Application No. 09/468,230 prior to the expiration date of the full statutory term

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as presently shortened by any terminal disclaimer of U.S. Patent 6,236,917 in the event that U.S. Patent 6,236,917 later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims cancelled by a Reexamination Certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

The undersigned whose signature and title appear below is empowered to act on behalf of petitioner.

I declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001, Title 18, of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

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CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

A check in the amount of \$110.00 is enclosed for the Terminal Disclosure fee. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036.

Respectfully submitted,

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Date: January 7, 2004

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